REMARKS

Claims 1-2, 4, 6, and 8-15 are pending. Claims 14 and 15 have been canceled. No new matter has been added. The rejections of the claims are respectfully traversed in light of the following remarks, and reconsideration is requested.

Rejections Under 35 U.S.C. § 103

Claims 1-2, 4, 6, and 8-13 are rejected under 35 U.S.C. § 103(a) as being obvious over Kazama (U.S. Patent No. 6,043,666) (the '666 patent) in view of Prival (U.S. Patent No. 3,251,121).

In rejecting the claims, the Examiner writes in part that the '666 patent has a common assignee and inventor with the instant application, and that based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). Thus, this rejection under 35 U.S.C. 103(a) may be overcome by a showing under 37 C.F.R. 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this Application and is thus not an invention "by another".

Applicant submits that the '666 patent to Kazama is not a patent granted on an application for patent "by another" as required under 35 U.S.C. § 102(e). The sole inventor of the present Application is identical to the sole inventor of the '666 patent (*See* Declaration of Toshio Kazama, attached hereto as Attachment A). Accordingly, the '666 patent is not a proper prior art reference, and Applicant requests withdrawal of the rejections under 35 U.S.C. § 103.

Even if the '666 patent and Prival were somehow to be considered prior art, Applicant submits the cited references do not disclose or suggest the combination of the elements as recited in the claims. In particular, Prival discloses reed-type switch contacts, which does not disclose or suggest material resistant to solder deposition as in the present invention but anti-adhesion characteristics between two contact surfaces made of like material. Prival does not disclose or suggest solder or the problem of solder deposition onto a contact surface of unlike material.

HAYNES & BOONE LLP
18200 Von Karman
SUITE 725
IRVINE, CA 92612
(949) 752-7040
FAX (214) 200-0853

Applicant also submits that Prival is directed toward nonanalogous art remote from the claimed invention and that a person of ordinary skill in the claimed art would not look to Prival and its related art to solve the problem treated by the claimed invention. Prival is wholly unrelated to "a conductive contact member for establishing a temporary electric contact by being applied under a resilient force to an object to be contacted that includes solid solder" as recited in independent Claims 1, 9, and 10. Thus, there is no teaching or suggestion in Kazama and Prival for combining or modifying the references.

In contrast, Claim 1 recites a "conductive contact member comprising a compression coil spring formed of a wire with a layer of highly electrically conductive material resistant to solder deposition, wherein the layer consists of gold containing a small amount of silver, contains no palladium, and is formed at least over a conductive contact part of said compression coil spring so that said conductive contact part of said compression coil spring may not be contaminated by deposition of solder from said object to be contacted."

Claim 9 similarly recites a "conductive contact member comprising a compression coil spring formed of a wire with a layer of highly electrically conductive material resistant to solder deposition, wherein the layer consists of an alloy of gold added with silver, contains no palladium, and is formed at least over a conductive contact part of said compression coil spring so that said conductive contact part of said compression coil spring may not be contaminated by deposition of solder from said object to be contacted."

Claim 10 similarly recites a "conductive contact member comprising a compression coil spring formed of a wire with a layer of highly electrically conductive material resistant to solder deposition, wherein the layer consists of a homogeneous mixture of gold added with silver, contains no palladium, and is formed at least over a conductive contact part of said compression coil spring so that said conductive contact part of said compression coil spring may not be contaminated by deposition of solder from said object to be contacted."

Therefore, because Kazama is not prior art, and Kazama and Prival are not properly combinable, Claims 1, 9, and 10 are patentable over the cited references.

Claims 2, 4, 6, and 11 are dependent on Claim 1 and contain additional limitations that further distinguish them from Kazama in view of Prival. Therefore, Claims 2, 4, 6, and 11 are

HAYNES & BOONE LLP
18201 Von Karman
SUITE 725
IRVINE, CA 92612
(949) 752-7040
FAX (214) 200-0853

allowable over the cited references for at least the same reasons provided above with respect to Claim 1.

Claims 12 and 13 are dependent on Claims 9 and 10, respectively, and contain additional limitations that further distinguish them from Kazama in view of Prival. Therefore, Claims 12 and 13 are allowable over the cited references for at least the same reasons provided above for Claims 9 and 10, respectively.

Claim 14 is rejected under 35 U.S.C. § 103(a) as being obvious over Chang (U.S. Patent No. 5,500,605) in view of Prival, and Claim 15 is rejected under 35 U.S.C. § 103(a) as being obvious over Kato et al. (U.S. Patent No. 5,727,954) in view of Prival.

Claims 14 and 15 have been canceled, thus making the rejections of these claims moot.

In view of the foregoing, Applicant respectfully requests that the rejections under 35 U.S.C. § 103 be withdrawn.

HAYNES & BOONE, LLP
18200 Von Karman
SUITE 725
IRVINE, CA 92612
(949) 752-7040
FAX (214) 200-0853

CONCLUSION

For the above reasons, Applicant believes pending Claims 1-2, 4, 6, and 8-13 are now in condition for allowance and allowance of the Application is hereby solicited. If the Examiner has any questions or concerns, the Examiner is hereby requested to telephone Applicant's Attorney at (202) 654-4500.

Certificate of Transmission

Certificate of Transmission: I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (USPTO) via the USPTO's electronic filing system on the date below.

Electronically Filed by:

Annie McNally

Dated: July 30, 2009

Respectfully submitted,

/ David S. Park /

David S. Park
Attorney for Applicant(s)
Reg. No. 52,094

HAYNES & BOONE LLP
18200 Von Karman
SUITE 725
IRVINE, CA 92612
(949) 752-7040
FAX (214) 200-0853